

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF FOR APPELLANTS

Ex parte Yoshiaki SAKAGAMI, *et al.*

IMAGE TRANSMISSION SYSTEM FOR A MOBILE ROBOT

Serial No. 10/814,343

Appeal No.:

Group Art Unit: 2624

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Enclosure: Reply Brief

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Appellant:

Yoshiaki SAKAGAMI, *et al.*

Appeal No.:

Serial Number: 10/814,343

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Filed: April 1, 2004

Examiner: Elisa M. Rice

For: IMAGE TRANSMISSION SYSTEM FOR A MOBILE ROBOT

REPLY BRIEF

February 12, 2010

I. INTRODUCTION

This Reply Brief is filed in response to the Examiner's Answer mailed December 16, 2009. In the Examiner's Answer, while no new grounds of rejection were explicitly made, comments and explanations were provided which are tantamount to new points of argument. This Reply Brief, therefore, is submitted to address these new points of argument, and to clarify why all of claims 1-8, which are currently pending in the application, should be considered patentable over Higaki and Kuno, and therefore, should be found by this Honorable Board of Patent Appeals and Interferences to be allowable.

II. STATUS OF CLAIMS

Claims 1-8, all of the claims pending in the present application, were rejected; their respective rejections are the subject of this appeal.

III. APPELLANTS' ARGUMENTS

Appellant respectfully submits that each of pending claims 1-8 recites subject matter that is not taught, described, or suggested by Higaki and Kuno, whether taken individually or in combination.

In particular, in the Examiner's Answer it is submitted that "Applicant failed to show due diligence in waiting until March 4, 2004, with less than a month available, to initiate the filing of a US equivalent filing as shown by the order letter of March 4, 2004 that was sent from Oshima & Narushima to the law firm of Squire Sanders & Dempsey, LLP." Appellants respectfully submit that the Examiner is misapplying the showing of due diligence. Under the current standing of U.S. patent law, an application filed in the U.S. has the right of priority to an application filed in a WTO member country if filed within twelve months from the earliest date on which such foreign application was filed. See 35 U.S.C. § 119(a). Therefore, the order letter of March 4, 2004, albeit one month before the filing due date, simply demonstrates that the Appellants were still operating and working on the U.S. filing within the statutory allowed period. The Examiner appears to be indicating that because the order letter was given to Squire Sanders & Dempsey LLP within a month from the priority due date, that in it of itself shows lack of due diligence. Such contention is erroneous and improper.

As explained in Appellants Appeal Brief, and in the Declarations which have been filed under 37 CFR § 1.131, the subject matter of the present application corresponds to the subject matter which is described in Japanese Patent Application No. 2003-094171, which was filed on March 31, 2003, in Japan. The Appellants had the intent to file the U.S. patent application and claim priority rights under 35 USC § 119(a), as evidenced by an

order letter to their Japanese attorneys, Oshima & Narushima, on January 8, 2004. Copies of all pertinent documents are already in the file.

Furthermore, in the Examiner's Answer, it is contended that "Applicant merely asserts exercising due diligence in the Declaration under 37 CFR 1.131 filed on July 4, 2008." Applicant respectfully traverses such contention. The Declaration filed on July 4, 2008 provided detailed statements of facts explaining with particularity the steps made by the Applicant to secure a priority filing dates of the application in the U.S. Evidence of such was provided with a copy of a first order letter given to Squire Sanders & Dempsey LLP. The first order letter requested the filing of a U.S. Paris Convention application corresponding to the subject matter described in Japanese Patent Application No. 2003-094171. Also, a copy of the second order letter of March 4, 2004 was included with the Declaration. The second order letter was from Oshima & Narushima to Squire Sanders & Dempsey LLP on behalf of the Applicant instructing SSD to prepare and file the application in the United States claiming the benefits of the Japanese priority date. Therefore, contrary to the allegations made in the Examiner's Answer, the Applicant did not merely allege that they had been diligent. Evidence and a detailed statements of facts submitted by a representative of Honda Motor Co. Ltd. ("Applicant") were included in the Declaration. Therefore, the Declaration supports the Applicant's claim of due diligence.

The order letter of March 4, 2004 sent from Oshima & Narushima to the law firm of Squire Sanders & Dempsey LLP, instructing Squire Sanders & Dempsey to prepare and file the application in the United States by March 31, 2004, demonstrates an intent from the Appellants to claim benefit of the Japanese priority filing date. Because the Appellants were still operating within the statutory period of 12 months, such operation

clearly demonstrates that the Appellants had the diligent intent to pursue the filing of the U.S. application.

As explained in the Appeal Brief, the order letter from the Appellants was contained in a package containing several filing orders which had been sent to Squire Sanders & Dempsey, and it was not until April 1, 2004, that this application was noticed among the several patent applications. In the normal course, the order letter was erroneously placed with another application that was in the package. The subject U.S. application was immediately filed on April 1, 2004. There was a clerical error that resulted in the application being filed one day late. A clerical error resulting in a one-day delay is not evidence of a lack of diligence.

The Examiner's Answer once again erroneously contends that "a claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application." Appellants were not asserting a claim for priority in the Declaration of January 7, 2008, the Declaration of July 8, 2008, or in the Appeal Brief. Appellants presented the Declarations and the Responses in an effort to show that Appellants acted diligently to reduce the invention to practice through the filing of a United States patent application based upon Japanese Patent Application No. 2003-094171. The missing of the priority deadline by one day is not evidence of a lack of diligence. The attempt in the Office Action to connect the Paris Convention deadline to due diligence is a clear legal and factual error.

Under U.S. patent practice, a patentee must account for the entire critical period between the date of conception and the date of reduction to practice by showing either activity aimed at reduction to practice or legally adequate excuses for inactivity. The order letters to the Japanese and U.S. attorneys, and the filing date of April 1, 2004, is

clearly evidence of due diligence. The commission of a clerical error does not “undo” all of the diligence which took place.

Furthermore, Appellants respectfully submit that the difference between conception/due diligence and a claim for priority has been confused. The cases that are relied upon in the Office Action to formulate the conclusion that due diligence was not shown are cases in which the applicant did not show any intent to seek patent protection and did not demonstrate continuous activities in the development of the invention from conception to the reduction of the invention to practice (e.g., filing of an application).

Under U.S. patent practice, a patentee must account for the entire critical period between the date of conception and the date of reduction to practice by showing either activity aimed at reduction to practice or legally adequate excuses for inactivity. The order letters to the Japanese and U.S. attorneys, and the filing date of April 1, 2004, is clearly evidence of due diligence. The commission of a clerical error does not “undo” all of the diligence which took place. Therefore, Appellants respectfully submit that the Appellants have made an adequate showing of due diligence.

Accordingly, Appellants respectfully request that Higaki be excluded from being used to reject the present application. Because the rejections cannot stand without Higaki, it is respectfully requested that the rejections be withdrawn.

For the reasons explained above, it is respectfully submitted that the rejection of claim 1 is moot because *Higaki may not be used as prior art against the present application* and because Kuno fails to teach or suggest all the recitations of independent claim 1.

Although the Examiner indicates on page 20 of Examiner[’s Answer that Higaki,

not Kuno, is used to reject some of the features recited in independent claim 1, as explained above, Higaki cannot be used to reject the present claims. Kuno, in turn, does not teach or suggest, at least, “a power drive unit for moving the entire robot toward the detected human,” as recited in independent claim 1. Rather, from the description and figures provided in Kuno, the robot 5 is positioned in front of or next to the patient so the facial features may be detected and monitored. Instead, column 24, from line 6, of Kuno describes that the robot 5 can move its arms and hands, touching the bed or the subject. However, nothing in column 24 provides that the robot 5 has a driving mechanism to move the entire robot toward the detected human. As submitted above, the robot 5 is placed by a human in front of the patient.

Furthermore, Kuno fails to teach or suggest, at least, “means for detecting a **position of a hand** by searching for a skin color area **other than the face** inside the outline of the moving object,” emphasis added, as recited in independent claim 1. Based “on a **positional relationship between the face and the hand**,” independent claim 1 provides “means for recognizing a gesture and/or posture of a human.” (Emphasis added) Such feature is not taught or suggested in Kuno. Kuno does not teach or suggest a determination of a positional relationship between the face and the hand, where the position of the hand is detected by searching the skin color area. Rather, Kuno provides that the robot 5 detects the head of the patient and if the patient has moved from the bed. See column 9, lines 50-53. The robot 5 can also analyze the face features of the patient to determine if the subject is facing or facing away from the camera (See column 13, lines 1-9) and is demonstrating an abnormal feature (See column 14, lines 24-39). The

description of Kuno does not anticipate all of the features recited in independent claim 1.

Accordingly, it is respectfully asserted that Kuno fails to teach or suggest all the recitations of independent claim 1. It is respectfully requested that the rejection to the claims be withdrawn.

As such, Appellant respectfully requests that the rejection of claim 1 be reversed and the claim be allowed.

Claims 2-8 depend from claim 1. Accordingly, claims 2-8 are patentable for at least the reasons claim 1 is patentable, and further, because they recite additional features. Accordingly, it is respectfully requested that these rejections be reversed and claim 1-8 be allowed.

IV. CONCLUSION

For all of the above noted reasons, it is strongly contended that certain clear differences exist between the present invention as claimed in claims 1-8 and the prior art relied upon by the Examiner. It is further contended that these differences are more than sufficient that the present invention would not have been obvious to a person having ordinary skill in the art at the time the invention was made.

This final rejection being in error, therefore, it is respectfully requested that this honorable Board of Patent Appeals and Interferences reverse the Examiner's decision in this case and indicate the allowability of application claims 1-8.

In the event that this paper is not being timely filed, the Appellants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees which may be due with respect to this paper may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,
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